UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,298	04/04/2001	Larry Isaacson	4272/1	3679

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EXAMINER
BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/826,298	ISAACSON ET AL.
	Examiner	Art Unit
	Namrata Boveja	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 April 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>22-26 and 28-37</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>04 April 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/28/2001</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 22-26 and 28-37 are presented for examination.

Remarks

2.   In the applicant remarks, the applicant elects claims 22-26 and adds claims 28-

37. However, in the claims, the applicant indicates "Original" instead of "Withdrawn"

next to claim 21. Claim 21 is not one of the elected claims. The identifier should be

changed. Furthermore, the applicant indicates that claims 22-26 and 28-36 are

pending, when in fact claims 22-26 and 28-37 are the pending claims.

Objections

3.   The claims are objected to because of the following informalities. The term

"vender" is misspelled throughout the specification and the claims and should be spelled

"vendor." Appropriate correction is required.

Claim Rejections - 35 USC § 112

4.   The second paragraph of 35 U.S.C. 112 is directed to requirements for the

claims:

> The specification shall conclude with one or more claims particularly pointing out and
> distinctly claiming the subject matter, which the applicant regards as his invention.
> There are two separate requirements set forth in this paragraph:
> (A)   the claims must set forth the subject matter that applicants regard as their
> invention; and
> (B)   the claims must particularly point out and distinctly define the metes and
> bounds of the subject matter that will be protected by the patent grant.

5.   Claims 22-26 and 28-37 are rejected under 35 U.S.C. 112, second paragraph,

since the recitation of the term "enabling" doesn't positively recite the claim limitation.

Appropriate correction is required.

6.   Claim 34 is rejected under 35 U.S.C. 112, second paragraph. Claim 34 depends

from itself, so therefore it does not further limit the claim. Appropriate correction is

required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office

action:

> A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed
> publication in this or a foreign country or in public use or on sale in this country, more than one year prior to
> the date of application for patent in the United States.

7.   Claims 22, 24, and 28-37, are rejected under 102(b) as being anticipated by

Storey (5,774,870 hereinafter Storey).

In reference to claim 22, Storey discloses a method for awarding credits

redeemable for products (Abstract). Storey also teaches the said method comprising of

enabling a user to electronically place a purchase order from a vendor (col. 3 lines 7-21,

col. 5 lines 29-35, and Figures 1 and 2); tracking a monetary value of said purchase

order and converting said monetary value into earned credits which a user can redeem

for products from the vendor during one or more subsequent ordering sessions (col. 5

lines 36-50 and Figure 2); maintaining a list of products which can be acquired with said

earned credits (col. 8 lines 3-64); said list having at least a product name and a product

value expressed in credits (col. 8 lines 28-64); making said list available for searching

during the subsequent ordering session (col. 8 lines 9-27, col. 9 lines 6-16); and

enabling said user to search for and select said products in exchange for said earned

credits (col. 9 lines 6 to col. 10 lines 6).

8.   In reference to claim 24, Storey teaches the method further comprising enabling

said user to redeem said earned credits during one or more ordering sessions (col. 9

lines 37 to col. 10 lines 6); tracking credits earned and credits redeemed throughout

multiple ordering sessions and adjusting remaining earned credit balance (col. 5 lines

36-46, col. 9 lines 37 to col. 10 lines 6, and Figure 4).

9.   In reference to claim 28, Storey teaches the method further comprising storing

earned credits data in a database; the earned credits data is based on said earned

credits (col. 5 lines 36-46, col. 9 lines 17-44, and Figure 2).

10.   In reference to claim 29, Storey teaches the method wherein said list is stored in

a database (col. 8 lines 17-64 and Figures 3 and 4).

11.   In reference to claim 30, Storey teaches the method wherein said list is ordered

based on increasing dollar value of the products (i.e. increasing point value of the

products is directly co-related to increasing dollar value of the products, the dollar value

is utilized in the invention to determine which products show up on the list for different

amounts of points (col. 8 lines 24-64).

12.   In reference to claim 31, Storey teaches the method wherein said list includes

(i.e. comprises) product information (col. 3 lines 7-34), product number, and product unit

of measure.

13.   In reference to claim 32, Storey teaches the method wherein said list is

searchable via at least one of a search engine and a browser (col. 2 lines 54-65, col. 7

lines 56 to col. 9 lines 16, and Figure 1).

14.   In reference to claim 33, Storey teaches the method wherein the method is

performed via a computer system, a computer is being used to access the Internet and

to create databases that are needed for carrying out the invention (col. 2 lines 54-65,

col. 7 lines 5-7 and lines 56 to col. 9 lines 16, and Figure 1).

15.   In reference to claim 34, Storey teaches the method wherein said computer

system is a client-server based system (col. 2 lines 54-65, col. 3 lines 22-34, and

Figures 1-4) including (i.e. comprising) a database (col. 8 lines 17-64 and Figures 3 and

4) and a server (col. 2 lines 54-65 and Figure 1), and said list is displayable on said

client (col. 8 lines to col. 9 lines 29 and Figure 4).

16.   In reference to claims 35 and 37, Storey teaches a system comprising a

processor, a computer is being used to access the Internet and to create databases that

are needed for carrying out the invention (col. 2 lines 54-65, col. 7 lines 5-7 and lines 56

to col. 9 lines 16, and Figure 1), and an apparatus for awarding credits redeemable for

products; at least one arrangement configured to communicate with the processor via a

computer network (col. 2 lines 56-61 and Figure 1); a computer-readable storing

medium storing a set of instructions (i.e. a computer program) (col. 5 lines 37-51, col. 5

lines 52 to col. 6 lines 19, col. 7 lines 45-55, col. 9 lines 17-29, col. 10 lines 7-22, and

Figure 6), the set of instructions capable of being executed by the processor to

implement a method for awarding credits redeemable for products (col. 9 lines 37-67

and Figure 4), the set of instructions effective to perform the steps of: enabling a user to

electronically place a purchase order from a vendor (col. 3 lines 7-21, col. 5 lines 29-35,

and Figures 1 and 2); tracking a monetary value of said purchase order and converting

said monetary value into earned credits which a user can redeem for products from the vendor during one or more subsequent ordering sessions (col. 5 lines 36-50 and Figure 2); maintaining a list of products which can be acquired with said earned credits (col. 8 lines 3-64); said list having at least a product name and a product value expressed in credits (col. 8 lines 28-64); making said list available for searching during the subsequent ordering session (col. 8 lines 9-27, col. 9 lines 6-16); and enabling said user to search for and select said products in exchange for said earned credits (col. 9 lines 6 to col. 10 lines 6).

17.   In reference to claim 36, Storey teaches a computer-readable storing medium (i.e. a computer program) (col. 5 lines 37-51, col. 5 lines 52 to col. 6 lines 19, col. 7 lines 45-55, col. 9 lines 17-29, col. 10 lines 7-22, and Figure 6), comprising a set of instructions, the set of instructions capable of being executed by a processing arrangement to implement a method for awarding credits redeemable for products (col. 9 lines 37-67 and Figure 4); the set of instructions effective to perform the steps of: enabling a user to electronically place a purchase order from a vendor (col. 3 lines 7-21, col. 5 lines 29-35, and Figures 1 and 2); tracking a monetary value of said purchase order and converting said monetary value into earned credits which a user can redeem for products from the vendor during one or more subsequent ordering sessions (col. 5 lines 36-50 and Figure 2); maintaining a list of products which can be acquired with said earned credits (col. 8 lines 3-64); said list having at least a product name and a product value expressed in credits (col. 8 lines 28-64); making said list available for searching during the subsequent ordering session (col. 8 lines 9-27, col. 9 lines 6-16); and

enabling said user to search for and select said products in exchange for said earned

credits (col. 9 lines 6 to col. 10 lines 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

18.   Claims 23 and 25 are rejected under U.S.C. 103(a) as being unpatentable over

Storey in view of Rose ("Plastic that pays you back." Money. November 1998. Vol. 27,

Iss. 11. Pg. 196 hereinafter Rose).

In reference to claim 23, Storey teaches the method wherein said earned credits

are displayed (col. 5 lines 41-47). Storey does not teach displaying earned credits as a

dollar value. Rose teaches displaying earned credits as a dollar value (page 2 lines 1-4

and lines 12-18). It would have been obvious to modify Storey's invention for displaying

earned reward credits in points to include displaying earned reward credits in dollars to

allow users to receive a cash back reward in lieu of a free product reward to

accommodate different user preferences. Furthermore, cash is a form of a reward, and

may be used by the user to purchase something that is not available on the website

under the reward products list, thereby increasing user options.

19.   In reference to claim 25, Storey does not teach the method further comprising

setting a predetermined maximum amount of said earned credits, which the said user

can accumulate. Rose teaches setting a predetermined maximum amount of said

earned credits, which the said user can accumulate (page 2 lines 14-17). It would have

been obvious to modify Storey's invention for rewarding earned credits for making

purchases by setting a limit on the maximum amount of said credits a user can

accumulate say in a time period such as one year to prevent a user that may have

made one large purchase only from utilizing the credits earned from that purchase to

receive free rewards for the remainder of the year without giving the user an incentive to

come back frequently to make multiple purchases throughout the year. Furthermore,

the sponsor of the reward program may have a limited budget the company is able to

allocate to the rewards program and may therefore need to set a maximum cap per user

to ensure that as many users as possible are able to receive some reward benefit for

making purchases.

20.   Claim 26 is rejected under U.S.C. 103(a) as being unpatentable over Storey in

view of official notice.

Claim 26 recites the method further comprising setting a predetermined

maximum amount of time after which unredeemed earned credits expire. In reference

to claim 26, official notice is taken that it is old and well known to set expiration dates on

earned credits by credit card companies that reward airline miles for example for

making purchases, since this encourages users to make more frequent purchases and

leads to user loyalty for using that same credit card for making purchases each time to

reach the award level faster or risk losing all the miles that have been accumulated to

date. It would have been obvious to a person of ordinary skill in the art at the time of

the applicant's invention to include setting an expiration date for the use of the earned credits in order to obtain the above mentioned advantage.

Conclusion

21.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

a)   Bloomberg News. "EarthLink Visa card offers 2% rebate to online

shoppers." Orange County Register. February 14, 1999. Pg. K.05.

Teaches an online shopping cash reward program started by BankOne.

b)   Branscum, Deborah. "Click your way to discounts." Newsweek. August

31, 1998. Vol. 132, Iss. 9. Pg. 60, 1. Teaches incentive programs

featured by ClickRewards, CyberGold, Intellipost, Netcentives, and

MotivationNet that give out gift certificates for purchases.

c)   Eggleston Patent Number 6,061,660. Teaches a system and method for

incentive programs and award fulfillment.

d)   Postrel Patent Number 6,829,586. Teaches a method and system for

aggregation of reward points for payment of auctioned items.

e)   PR Newswire. "MyPoints.com One of Top 25 Most Popular Shopping

Sites on the Web." March 22, 1999. Pg. 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the
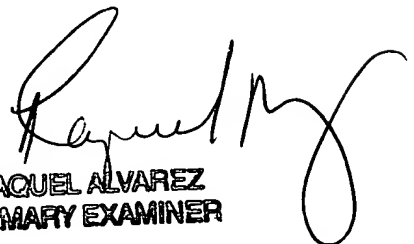
examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

June 27, 2005

RAQUEL ALVAREZ
PRIMARY EXAMINER